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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAE-GUNN JEI and SEO-YOUNG PARK

Appeal 2008-5278
Application 10/777,807
Technology Center 2600

Decided¹: March 27, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
rejection of claims 1-10 and 14-19 (*see* App. Br. 9-10, Final Rejection,

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

mailed October 4, 2006). We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellants invented a mobile terminal circuit for transmitting radio frequency identification (RFID) data to a RFID reader (*See generally* Spec. 4-6).

Claim 1, which further illustrates the invention, follows:

1. A mobile terminal circuit for transmitting radio frequency identification (RFID) data to an RFID reader, comprising:
an antenna for communicating with the RFID reader;
a memory portion for storing the RFID data together with mobile terminal protocol data;
a codec for encoding the RFID data into RFID codec data;
a modulator connected to the codec, for modulating the RFID codec data into RFID modulation data;
a processor connected to the memory portion, for extracting RFID data stored in the memory portion and delivering the extracted RFID data to the codec;
a detector connected to the antenna and the processor, for informing the processor of an approach of the RFID reader;
a first clock generator connected to the processor and the memory portion, for providing operation timing to the processor and the memory portion; and
a second clock generator connected to the first clock generator, the codec, and the modulator, for providing operation timing to the codec and the modulator.

The Rejections

The Examiner relies upon the following prior art references as evidence of unpatentability:

Jenkins, IV	US 6,172,518 B1	Jan. 9, 2001
Kuttruff	US 2002/0080864 A1	Jun. 27 2002
Pratt	US 2004/0198233 A1	Oct. 7, 2004
Twitchell Jr.	US 2005/0215280 A1	Sep. 29, 2005
Ohkawa	US 6,972,662 B1	Dec. 6, 2005
Appellants' Admitted Prior Art		

The following Examiner's rejections are before us for review:

1. The Examiner rejected claims 1, 2, 5, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff and Ohkawa.
2. The Examiner rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa and Pratt.
3. The Examiner rejected claims 6, 7, and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa and Twitchell Jr.
4. The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa, Twitchell Jr. and Jenkins, IV.
5. The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff et al., Ohkawa., Twitchell Jr., and further in view of Appellants' Admitted Prior Art.
6. The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa, Twitchell Jr. and Pratt.

Rather than repeat the arguments of the Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by

Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants group the arguments according to the following: (A) claims 1-5 and 14-15; (B) claims 6-10 and 16-19.² Each group will be addressed separately.

Claims 1-5, 14, and 15

Appellants state that claim 1 requires a first clock generator for generating a system clock of the mobile terminal and a second clock generator for generating a clock necessary for RFID operation (App. Br. 11). Appellants indicate that neither Kuttruff, Ohkawa nor Twitchell Jr. discloses such features however the Appellants do not expand upon the argument in regards to claim 1³ (App. Br. 11). Appellants argue that the Examiner improperly rejects claim 14 by using the combination of Kuttruff and Ohkawa to disclose the employment of separate first and second clocks for the receiving and transmission portion of the RFID device (App. Br. 13, lines 3-5).

² Although claims 3 and 4 have been grouped by Appellants with claims 1, 2, 5 and 14-15, we nonetheless consider them separately because the additional reference to Pratt has been applied against claims 3 and 4. Although claims 8-10 have been grouped by Appellants with claims 6, 7 and 16-19, we likewise consider them separately because additional references have been applied against claims 8-10.

³ Claims 1, 2, 5, 14, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kuttruff and Ohkawa, and claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kuttruff, Ohkawa et al. and Pratt.

It is the Examiner's position that Ohkawa discloses a RFID device with a first clock generator (61) and a second clock generator (62) (Ans. 16-17).

ISSUE

1. Have the Appellants shown that the Examiner erred in finding that Kuttruff in combination with Ohkawa disclose the limitation, "a second clock generator connected to the first clock generator" in claim 1 and the limitation "including a second clock generator for providing RFID operation timing" in claim 14 in rejecting claims 1 and 14 under 35 U.S.C. § 103?

FINDING OF FACT

1. Figure 2 of Ohkawa

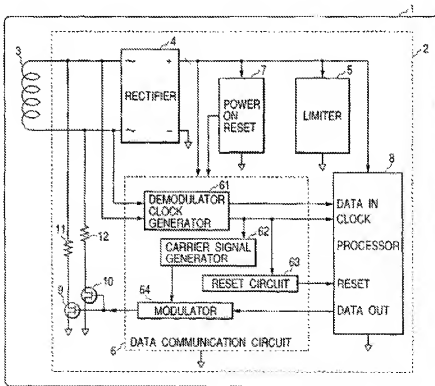


Figure 2 of Ohkawa discloses an IC card circuit design having a carrier signal generator circuit (62) which divides a frequency of the clock signal from the demodulator clock generator (61) to a predetermined frequency.

PRINCIPLES OF LAW

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Claims 1-5, 14, and 15

Claims 1, 2, 5, 14, and 15

The Appellants argue that the carrier signal generator (62) of Ohkawa is not an independent clock as required by the claims because it divides the frequency of clock (FF1) and does not have an independent frequency other than some multiple of the clock (Reply Br. 4). This would make the carrier signal generator a slave of the clock and not a second clock generator as required by the claims (Reply Br. 4).

The Appellants also argue that the Ohkawa reference makes no mention of a second clock generator to provide RFID operation timing using

a system clock output from a first clock generator (App. Br. 13-14). It is the Examiner's position that although Ohkawa is silent regarding the connection to an encoder, Ohkawa teaches employing a first and second clock for the receiver and transmission part of the RFID device (Ans. 16-17). Therefore the combination of Kuttruff and Ohkawa would render the limitation unpatentable because Kuttruff has an encoder and modulator in the transmission path in the RFID device (Ans. 16-17).

In addressing the Appellants' arguments about the characterization of Ohkawa's carrier signal generator as a second clock generator, the Examiner does not provide any rationale or support for his characterization (Ans. 17). The Examiner simply restates his position by referring to the signal carrier generator as a second clock generator (Ans. 17). Based on the record before us, we agree with the Appellants that Ohkawa fails to disclose a second clock generator. Further, since Ohkawa does not disclose a second clock generator, the Appellants have shown that the combination of Kuttruff and Ohkawa fails to disclose the employment of separate first and second clocks for the receiving and transmission portions of the RFID device as required by claims 1 and 14.

For the above reasons, Appellants have shown that the Examiner erred in rejecting claims 1, 2, 5, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff and Ohkawa.

Claims 3 and 4

The obviousness rejection of claims 3 and 4 is likewise reversed because of their dependency from claim 1, and because Pratt does not address the deficiencies of Kuttruff and Ohkawa.

Claims 6-10 and 16-19

Claims 6-10

Appellants argue that claims 6 and 7 include similar recitations as those disclosed in claim 1 such as a first clock generator and a second clock generator required for RFID operation (App. Br. 15-17). Appellants maintain for reasons stated previously that the combination of Kuttruff, Ohkawa and Twitchell Jr. references do not address the first and second clocks limitations of claim 14 (App. Br. 15).⁴

ISSUE

2. Have the Appellants shown that the Examiner erred in finding the combination of Kuttruff, Ohkawa and Twitchell Jr. discloses a second clock generator connected to the first clock generator for providing a second operation timing to the circuit in rejecting claims 6 and 7 under 35 U.S.C. § 103?

ANALYSIS

As we previously determined based upon the record before us, Ohkawa does not disclose a second clock generator. Twitchell Jr. does not address the deficiencies of Kuttruff and Ohkawa (Ans. 17). Both claims 6 and 7 have limitations requiring first and second clock generators. Thus, Appellants have shown that the Examiner erred in rejecting claims 6 - 10 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa and Twitchell Jr.

⁴ Claims 1-2, 5, 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kuttruff and Ohkawa.

Claims 16-19

Appellants argue that Twitchell Jr. does not qualify as prior art because it was filed as a PCT application and has a 35 U.S.C. § 371 date and 35 U.S.C. § 102(e) date of November 12, 2004 which is after February 12, 2004, the filing date of the pending application (App. Br. 16). The Examiner indicates that Twitchell Jr. has a priority date of May 16, 2002 which predates the Appellants' effective filing date of October 7, 2003 (Ans. 17).

Twitchell Jr. was cited to teach the use of a microprocessor to control power to a module (Ans. 17). The Examiner indicates that Kuttruff discloses a power block comprising a rectifier and a voltage regulator for supplying power to the RFID module illustrated in figure 2 (Ans. 17). The Examiner further indicates that Ohkawa discloses a power block connected to the first clock generator, the processor and the RFID module (Ans. 17).

Appellants argue that the obviousness rejection for claim 16 is improper for reasons given in regard to claim 6 although there are some differences between the two claims (App. Br. 17). The Appellants provide the example that claim 6 recites "a second clock generator connected to the first clock generator" whereas Claim 16 does not. (App. Br. 17). Appellants do not indicate what claim 16 discloses that claim 6 does not, thus choosing to focus on claim 6 instead of claim 16.

Appellants further state that the rejection of claim 16 is improper because the Examiner grouped the rejection for claim 16 along with claim 6 without addressing the individual limitations of claim 16 (App. Br. 17). The Examiner indicates that the claims have been addressed individually (Ans. 10, 11 and 18).

Appellants also argue that the obviousness rejection of claim 18 is improper for reasons given in regard to claim 6 although there are some differences between the two claims (App. Br. 18). The Appellants provide the example that claim 18 recites "a processor connected to the power block, the first clock generator, the memory portion, and the RFID module, for enabling an operation of the power block, extracting the RFID data, and delivering the extracted RFID data to the RFID module" whereas Claim 6 does not. (App. Br. 18). Appellants state the rejection of claim 18 is improper because the Examiner grouped the rejection for claim 18 along with claim 6 without addressing the individual limitations of claim 18 (App. Br. 18). The examiner indicates that the claims have been addressed individually (Ans. 11, 12 and 18).

ISSUES

3. Does Twitchell Jr. qualify as prior art?
4. Have the Appellants shown that the Examiner erred in finding that Kuttruff, Ohkawa and Twitchell Jr. collectively teach the invention claimed in claim 16 under 35 U.S.C. § 103 by only addressing the limitations of claim 6?
5. Have the Appellants shown that the Examiner erred in finding that Kuttruff, Ohkawa and Twitchell Jr. collectively teach the invention claimed in claim 18 under 35 U.S.C. § 103 by only addressing the limitations of claim 6?

FINDING OF FACT

2. Twitchell Jr. is the 35 U.S.C. 371 (c) application of PCT/US03/14987 filed May 14, 2003 which claims benefit of application 60/380,195 filed May 14, 2002 and application 60/380,670 filed May 16, 2002.

ANALYSIS

Appellants argue that Twitchell Jr. does not qualify as prior art because it was filed as a PCT application and has a 35 U.S.C. § 371 date and 35 U.S.C. § 102(e) date of November 12, 2004 which is after February 12, 2004 filing date of the pending application (App. Br. 16). This argument is not persuasive because the Appellants fail to supply a rationale as to why Twitchell Jr.'s priority date is not the date of the provisional applications as indicated by the Examiner (FF2). Twitchell Jr. qualifies as prior art.

Appellants argue that the Examiner has not met his burden of establishing a prima facie case of obviousness in respect to claim 16 because the Examiner rejects claim 6 without addressing the merits of claim 16 separately (App. Br. 17). The Examiner addresses claim 16 separately, thus, establishing a prima facie case of obviousness (Ans. 9-10). The Appellants do not present arguments addressing the merits of the rejection of claim 16 by the combination of Kuttruff, Ohkawa and Twitchell Jr. Accordingly, we will sustain the rejection of claim 16.

Appellants argue that the Examiner has not met his burden of establishing a prima facie case of obviousness in respect to claim 18 because the Examiner rejects claim 6 without addressing the merits of claim 18 separately (App. Br. 18). The Examiner addresses claim 18 separately thus establishing a prima facie case of obviousness (Ans. 11-12). The Appellants do not present arguments addressing the merits of the rejection of claim 18

by the combination of Kuttruff, Ohkawa and Twitchell Jr. Accordingly, we will sustain the rejection of claim 18.

The Appellants chose not to argue the merits of the rejection of claims 17 and 19 separate from their arguments provided for claims 16 and 18 respectively. For the above reasons, the Appellants have not shown that the Examiner erred in rejecting claims 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kuttruff, Ohkawa and Twitchell Jr.

CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in finding that Kuttruff in combination with Ohkawa disclose the limitation, “a second clock generator connected to the first clock generator” in claim 1 and the limitation “including a second clock generator for providing RFID operation timing” in claim 14 in rejecting claims 1 and 14 under 35 U.S.C. § 103.
2. Appellants have shown that the Examiner erred in finding the combination of Kuttruff, Ohkawa and Twitchell Jr. discloses a second clock generator connected to the first clock generator for providing a second operation timing to the circuit in rejecting claims 6 and 7 under 35 U.S.C. § 103.
3. Appellants have not shown that the Examiner erred in relying on Twitchell Jr. as prior art.
4. Appellants have not shown that the Examiner erred in finding that Kuttruff, Ohkawa and Twitchell Jr. collectively teach the invention claimed in claim 16 under 35 U.S.C. § 103 by only addressing the limitations of claim 6.

5. Appellants have not shown that the Examiner erred in finding that Kuttruff, Ohkawa and Twitchell Jr. collectively teach the invention claimed in claim 18 under 35 U.S.C. § 103 by only addressing the limitations of claim 6.

DECISION

The decision of the Examiner to reject claims 16-19 is affirmed, and the decision of the Examiner to reject claims 1-10, 14 and 15 is reversed.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

gvw

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